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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,220	01/28/2000	Alison Joan Lennon	169.1595	1967
5514	7590	12/27/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PHAM, HUNG Q	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/493,220	Applicant(s) LENNON, ALLISON JOAN	
	Examiner HUNG Q PHAM	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-18,32-37,39-47,49-53,67,74 and 119-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-18,32-37,39-47,49-53,67,74 and 119-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/13/2004 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 32, 36, 67, 71 and 74 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 32, 67 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 32, 67 and 74 recite the limitation *the feature* in the step *associating the chosen representative value*. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 2, 4-9, 11, 12, 14-18, 32, 33, 35-37, 39-44, 46, 47, 49-53, 67, 68, 70, 71, 74, 119-121 are rejected under 35 U.S.C. 102(b) as being anticipated by DeRose et al. [USP 5,644,776].**

Regarding claims 1, 36 and 71, DeRose teaches a system and method for indexing and navigating the electronic document (Abstract). As illustrated at FIG. 8 is the process of *reading the descriptions of the resources* (Col. 10, Line 43-Col. 12, Line 15). As illustrated at FIG. 4, *the description of the resource having* element descriptors such as BOOK, CHAPTER, or SECTION as *descriptor components having* their own text as *attributes* (Col. 8, Line 43-Col. 9, Line 24). As illustrated at FIG. 12, *the attributes of* element descriptors *represent at least two axes of access to the resources, wherein at least*

one axis of access is TABLE OF CONTENT as table-of-contents classification and LOOKUP WINDOW (Col. 16, Line 57-Col. 17, Line 15 and Col. 17, Lines 32-48), the description being separate from the resources (Col. 12, Line 56-Col. 13, Line 6). Returning back to FIG. 6, each element descriptor as descriptor component that has an attribute representative of a table of contents also has a link to a corresponding portion of the electronically-accessible resources (Col. 9, Lines 25-61). As illustrated at FIG. 12 is the step of displaying items for selection (Col. 17, Lines 5-15) in accordance with the selecting of TABLE OF CONT as an attribute representative of a first axis of access that is a table-of-contents classification, each item being associated with a corresponding descriptor component of a description read in reading step (FIG. 6). When the table of contents is displayed on the screen, a section of the table of contents may then be expanded responsive to a mouse event or other indication by a user, by displaying the titles for any immediate sub-elements of a selected displayed element and for subsequent elements which were in the original display (Col. 17, Lines 5-15) as the step of receiving a selection of one or more descriptor components using the displayed items. As described at FIG. 13, LOOKUP WINDOW for searching a particular term as an indication of a further axis of access is received, and displaying, in response to the received indication, further items for selection in accordance with LOOKUP WINDOW at the bottom of FIG. 13 as an attribute representative of the further axis of access, wherein the further items correspond to child descriptor components of the selected one or more descriptor components (FIG. 12, TEXT VIEW of selected shoes at LOOKUP WINDOW). DeRose further discloses that the processed structure of FIG. 6 is stored in a random-access medium (Col. 13, Lines 1-6).

As illustrated at FIG. 14, *in response to a further selection of a descriptor component having an attribute representative of a table-of-content classification*, for example ROUTINE ADJUSTMENTS, the text of this section as *a portion of the electronically-accessible resources via the pointer as link of the selected descriptor component* (Col. 9, Line 50-Col. 10, Line 10) is rendered, and the technique of rendering implies the text is *read* from the random-access medium using pointer to locate the location of the text.

Regarding claims 2 and 37, DeRose teaches all the claim subject matters as discussed above with respect to claims 1 and 36, DeRose further discloses *description is represented by a tree of descriptor components, and one or more of said descriptor components have descriptor components as descendents* (FIG. 3).

Regarding claims 4 and 39, DeRose teaches all the claim subject matters as discussed above with respect to claims 1 and 36, Duwaer further discloses *one of said axes of access is an index classification* (Col. 17, Lines 32-48).

Regarding claims 5 and 40, DeRose teaches all the claim subject matters as discussed above with respect to claims 1 and 36, DeRose further discloses *the descriptions of the resources are generated using a description scheme as a template, and the description scheme uses a declarative description definition language which contains definitions for descriptor components of the descriptions of the resources* (FIG. 4).

Regarding claims 6 and 41, DeRose teaches all the claim subject matters as discussed above with respect to claims 5 and 40, DeRose further discloses *the attributes of the descriptor components are defined in the description scheme* (FIG. 4).

Regarding claims 7 and 42, DeRose teaches all the claim subject matters as discussed above with respect to claims 5 and 40, Duwaer further discloses *the attributes of the descriptor components are a persistent item of the description scheme* (FIG. 4).

Regarding claims 8 and 43, DeRose teaches all the claim subject matters as discussed above with respect to claims 5 and 40, DeRose further discloses *the attributes of the descriptor components are instantiated by an application when required* (Col. 8, Lines 30-42).

Regarding claims 9 and 44, DeRose teaches all the claim subject matters as discussed above with respect to claims 8 and 43, DeRose further discloses *the attributes of the descriptor components are instantiated using a rule that is associated with the description scheme* (Col. 8, Line 43-Col. 9, Line 13).

Regarding claims 11 and 46, DeRose teaches all the claimed subject matters as discussed in claims 1 and 36, DeRose further discloses *the resources comprise an electronic document or resource available over the World Wide Web* (Col. 7, Lines 60-66 and Col. 24, Lines 4-18).

Regarding claims 12 and 47, DeRose teaches all the claimed subject matters as discussed in claims 1 and 36, DeRose further discloses *the resources comprise an electronic device* (FIG. 1).

Regarding claims 14 and 49, DeRose teaches all the claim subject matters as discussed above with respect to claims 1 and 36, DeRose further discloses *axes of access are determined by rules operating on the description* (FIG. 13).

Regarding claims 15 and 50, DeRose teaches all the claimed subject matters as discussed in claims 1 and 36, DeRose further discloses *axes of access are determined during the generation of the description of the resource* (Col. 12, Line 56-Col. 13, Line 6).

Regarding claims 16 and 51, DeRose teaches all the claim subject matters as discussed above with respect to claims 1 and 36, Duwaer further discloses *attributes of said descriptor components representative of said at least two axes of access are inferred from the content of the description* (FIGS. 4, 12-13).

Regarding claims 17 and 52, DeRose teaches all of the claimed subject matter as discussed above with respect to claims 16 and 51, DeRose further discloses *attribute of a said descriptor component is inferred to be a table of content descriptor if the said descriptor component contains a reference to a resource or a section of a resource* (FIG. 6).

Regarding claims 18 and 53, DeRose teaches all of the claimed subject matter as discussed above with respect to claims 17 and 52, DeRose further discloses *attribute of a said descriptor component is inferred to be an index descriptor if the said descriptor component is not inferred to be a table of contents descriptor* (FIG. 11).

Regarding claims 32, 67 and 74, DeRose teaches a system and method for indexing and navigating the electronic document (Abstract). As illustrated at FIG. 8 is the process of parsing a SGML document as *a resource* by reading markup tag and text chunks to generate an element directory (FIG. 6, Col. 12, Lines 56-59) and frequency record table (FIG. 9, Col. 13, Lines 23-29) as *the description of the resource*. As illustrated at FIG. 6, a plurality of descriptors as *the descriptor components each of which comprises a type name 102 as a name of a feature of the resource and an associated representative value for the feature*, and an element identifier as *a table of contents attribute*, fields 92-100 contains identifiers for pointing to another corresponding portion of the SGML document as *link to a corresponding portion of the resource* (FIG. 6, Col. 9, Lines 25-42 and Col. 16, Lines 48-55). As illustrated at FIG. 9 is a plurality of *descriptor components includes index attributes* (FIG. 9, Col. 13, Lines 23-29). The element directory and frequency table are stored in the memory (Col. 13, Lines 1-6 and Col. 14, Lines 48-52). The element directory and frequency table is traversed to create TABLE OF CONTENT for navigating and LOOKUP WINDOW for full text searching as illustrated at FIG. 12-13 (Col. 12, Lines 59-66 and Col. 15, Lines 27-33). As seen, the element directory and

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frequency table are stored after parsing the SGML document indicates *the description being separate from the resource*. The technique of traversing the element directory, and frequency record table for generating TABLE OF CONTENT and LOOKUP WINDOW implies the step *reading the description of the resource but not reading the resource*. In other words, the technique as discussed performs the step of *reading the description of the resource but not reading the resource, the description being separate from the resource and having descriptor components each of which comprises a name of a feature of the resource and associated representative value for the feature, the description also having one or more of the descriptor components including a table of contents attribute and one or more of the descriptor components including an index attribute, wherein the descriptor components that includes a table of content attribute also have a link to a corresponding portion of the resource*. As illustrated at FIG. 12 is the step of *displaying one or more tables of contents containing table of contents items, each table of contents item being associates with a corresponding descriptor component* (Col. 16, Lines 45-62) *that has a table of content attribute* (FIG. 6). As illustrated at FIG. 22 is the step of *receiving a selection of one displayed table of contents item for the annotation* (Col. 23, Line 60-Col. 24, Line 34). Returning back to FIG. 13, LOOKUP TABLE in FIG. 13 indicates the step of *displaying an index containing index items*, DeRose further teaches that *each displayed index item being associated with a corresponding descriptor component that has an index attribute and is associated with the selected table of content item* (FIG. 9, Col. 13, Lines 23-29). By clicking shoes in the LOOKUP WINDOW of FIG. 12 as the step of *receiving a selection of one displayed index item*, shoes as *the selected displayed index item is associated with BRAKE*

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SHOES as *the selected table of contents item* to have a TEXT VIEW of *shoes* (FIG. 12).

As disclosed by DeRose at Col. 17, Lines 32-48, another feature provided by the indexing and rendering methods enables cumulative search statistics to be displayed in combination with the table of contents as shown in FIGS. 12-13. A user may instruct the system to search on a given word in a document. The elements in which the selected word occurs may be determined from the frequency record for the selected word. By providing a style sheet for the table of contents which directs the rendering process to examine a selected variable, e.g. "word", which may store a value indicative of a selected search word, when a table of contents then is displayed, the number of occurrences in the element corresponding to the item for the selected word may be retrieved from its frequency record and displayed. Thus, a user may know how many times a word occurs in each section of a document whose table of contents item is displayed. A user may then determine relevant portions of the displayed document. As seen, the system is *received* an instruction to display a value indicative the occurrences of a selected search word as *a choice of a representative value for the selected index item*, the number of occurrences as *the chosen representative value is associated with* each section of table of contents item as *the feature which corresponds to the selected index item*, and as illustrated at the top right of FIG. 12, the number of occurrences of the word *shoes* indicates *the chosen representative value and its corresponding feature provide an annotation of the resource*.

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Regarding claims 33 and 68, DeRose teaches all of the claimed subject matter as discussed above with respect to claims 32 and 67, DeRose further discloses *description read in said reading step is represented by a tree of descriptor components, and one or more of the descriptor components have descriptor components as descendants* (FIG. 3).

Regarding claim 35, DeRose teaches all of the claimed subject matter as discussed above with respect to claim 32, DeRose further discloses the step of *choosing a representative value is predetermined* (Col. 17, Lines 32-48).

Regarding claim 70, DeRose teaches all of the claimed subject matter as discussed above with respect to claim 67, DeRose further discloses *operation of said means for selecting one said table of contents item is optional and if not performed said means for displaying an index displays all said index items associated with all said table of contents items* (the operational boxes at the bottom right of FIG. 13).

Regarding claim 119, DeRose teaches all of the claimed subject matter as discussed above with respect to claim 1, DeRose further discloses *the corresponding portion of the electronically-accessible resources is a spatially localized extent of the resources* (FIG. 3).

Regarding claim 120, DeRose teaches all of the claimed subject matter as discussed above with respect to claim 1, DeRose further discloses *the corresponding portion of the electronically-accessible resources is a temporally localized extent of the resources* (FIG. 22, after annotation).

Regarding claim 121, DeRose teaches all of the claimed subject matter as discussed above with respect to claim 32, DeRose further discloses *the corresponding portion of the resource is the resource* (FIG. 3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 10 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose et al. [SUP 5,644,776] in view of Rowe et al. [USP 6,073,148].

Regarding claims 10 and 45, DeRose teaches all the claim subject matters as discussed above with respect to claims 1 and 36, but does not explicitly disclose *the resources comprise an item of digital audiovisual content* (Col. 1, Lines 5-10). Rowe teaches an electronic document comprises an item of digital audiovisual content (Rowe, Col. 1, Lines 29-39). It would have been obvious for one of ordinary skill in the art at the time the invention was made to include item of digital audiovisual content in order to illustrate the content of an electronic document.

9. Claims 34 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose et al. [SUP 5,644,776].

Regarding claims 34 and 69, DeRose teaches all of the claimed subject matter as discussed above with respect to claim claims 32 and 67, but does not explicitly disclose the step of *associating the selected display index item is allowed only if the corresponding descriptor of the selected display index item is a valid descriptor for the table of contents item selected for annotation*. However, as illustrated at FIG. 13, a user can enter a term into the search box of LOOKUP WINDOW, and if the search term is invalid,

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obviously, there will be no annotation. It would have been obvious for one of ordinary skill in the art at the time the invention was made to include the condition of associating the number of occurrences of a word in order to annotate the table of content.

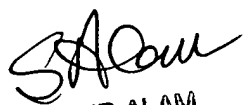
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
November 30, 2004


SHAHID ALAM
PRIMARY EXAMINER